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10/631,970	08/01/2003	Daniel Lee Hamilton	23952-0108	3665
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SUTHERLAND II SUTHERLAND, ASBILL & BRENNAN, LLC 999 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER ANDERSON, JOHN A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/631,970

**Applicant(s)**

HAMILTON ET AL.

**Examiner**

John A. Anderson

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 02/24/2004.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of the claims**

1. This action is in response to the application filed 08/01/2003. Claims 1-22 are pending and are examined.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
3. Claims 2, 10, 11, 13, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. As regards claims 2 and 13, the limitation "protects against financial loss" is vague and indefinite. There is a lack of antecedent basis for this limitation in the claim.
5. As regards claims 10 and 21, the limitation "associated with a shortest time period to complete payment" is vague and indefinite. There is a lack of antecedent basis for this limitation in the claim.
6. As regards claims 11 and 22, "the limitation "having a highest priority" is vague and indefinite. There is a lack of antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Moenickheim et al (US 2004/0088251 A1).
9. As regards claims 1 and 12, Moenickheim discloses a method for making a payment to a payee on behalf of a payor, comprising:
- receiving a payment request for a payment service provider to pay a payee on behalf of a payor; [0256]

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- identifying those of a plurality of risk reduction techniques available for fulfilling the received payment request based upon the received payment request; [0210]
- selecting an identified available risk reduction technique; and effecting payment in accordance with the selected risk reduction technique. [0191]

10. As regards claims 2 and 13, Moenickheim discloses wherein each of the plurality of risk reduction techniques protects against financial loss to the payment service provider in effecting payment on behalf of the payor. [0035, *Even though a consumer may only wish to receive e-bills, that consumer would have to fully enroll, in which supplemental information for risk management in addition to identity verification must be provided. Thus, the enrollment process ties together information required to receive e-bills with bank account information required to pay bills.*]

11. As regards claims 3 and 14, Moenickheim disclose wherein the plurality of risk reduction techniques includes at least two of:

i) determining, prior to directing funds to the payee in association with effecting payment, that payor funds are available,

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- ii) determining, prior to directing funds to the payee in association with effecting payment, that an entity is available from which to collect funds if funds cannot be collected from the payor in association with effecting the payment,
- iii) determining whether payment to the payee will be drawn on a deposit account associated with the payor, or drawn on a deposit account associated with an entity other than the payor, [0156]
- iv) directing funds to the payee a predetermined period of time subsequent to initiating an electronic debiting of a deposit account associated with the payor. [0074]

12. As regards claims 4 and 15, Moenickheim discloses wherein the selected risk reduction technique is the determining that payor funds are available, and further comprising:

- transmitting an electronic funds transfer file to debit the payor deposit account and to credit a deposit account associated with the service provider; *[0008, In any event, a service provider processes the payment requests and issues all debits, credits, and remittance advice associated with the payment requests.]*
- transmitting a confirmation request to a financial institution at which at least one of the payor deposit account and service provider deposit account is maintained subsequent to transmitting the electronic funds transfer file; *[0164, The electronic biller system 800A then determines if the subscriber information is included in a database associated with the subscriber system 800A and returns a response to*

*the EBSP system 700 via the network 600 between communications interfaces 812A and 712B. Alternatively, the electronic biller could send confirmation information of the availability of electronic billing or directly to the subscriber 607A.]*

- receiving a response to the transmitted confirmation request from the financial institution; *[0065, In response to the transmitted information identifying the first consumer, the first consumer receives information identifying a first candidate payee, which may also be a biller, from the electronic commerce service provider.]*
- wherein the transmitted confirmation request requests one of i) confirmation that the payor deposit account has been successfully debited, or ii) confirmation that the service provider deposit account has been successfully credited; *[ The electronic commerce service provider can electronically debit a deposit account associated with the consumer in completing a payment, can generate a draft drawn on the consumer's deposit account in completing the payment, or can electronically debit a credit account of the consumer in completing the payment.]*
- wherein the received response indicates one of i) a successful debiting of the payor deposit account, or ii) a successful crediting of the service provider deposit account; *[0007 In a Biller Direct model there are multiple ways that electronic payments can be performed. In one, an electronic biller A' through Z' provides all the functionality for completing the payment. That is, an electronic biller presents a user interface for payment via a communications channel 108A through 108Z,*

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*captures enrollment data for payments from the consumer 105, warehouses payment requests in data repositories 110 through 111, processes the payment requests, and issues all debits, credits, and remittance advice associated with payment requests.]*

- wherein the payment to the payee is effected responsive to receipt of the response, the payment drawn on the service provider deposit account. *[0060 The electronic commerce service provider can electronically debit a deposit account associated with the consumer in completing a payment, can generate a draft drawn on the consumer's deposit account in completing the payment, or can electronically debit a credit account of the consumer in completing the payment.]*

13. As regards claims 5 and 16, Moenickheim discloses wherein the selected risk reduction technique is the determining that an entity is available from which to collect funds if funds cannot be collected from the payor in association with effecting the payment, and further comprising: identifying the entity from which to collect funds if funds cannot be collected from the payor in association with directing the payment to the payee on behalf of the payor; wherein the payment is effected responsive to the identification of the entity; wherein the payment is drawn on a deposit account associated with the payment service provider; and wherein the identified entity is one of the payee and a consumer service provider with which the payor is associated. *[0332, However, the EBSP 601 may be*



*missing an important element, for example, the customer account number, and therefore the best that can be accomplished is a partial set up of that payee. The subscriber 607H cannot make an electronic payment to a partially set up payee. The subscriber 607H is required to supply additional information to complete the process].*

14. As regards claims 6 and 17, Moenickheim discloses wherein the selected risk reduction technique is the determining whether payment to the payee will be drawn on a deposit account associated with the payor, or drawn on a deposit account associated with an entity other than the payor, and further comprising:

- determining at least one of i) if a monetary amount of the payment request is less than a predetermined first threshold, ii) if a total monetary amount of payments completed on behalf of the payor within a first predetermined time period is less than a predetermined second threshold, and iii) if a volume of payments completed on behalf of the payor within a second predetermined time period is less than a predetermined third threshold; *[0210, The business rules introduced above include rules such as payment amount thresholds, payment frequency thresholds, or other business rules associated with risk processing.]*
- wherein, if it is determined that the monetary amount is less than the first threshold, that the total monetary amount is less than the second threshold, or

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that the volume is less than the third threshold, effecting payment includes issuing one of a check or an electronic funds transfer to the payee drawn on a deposit account associated with an entity other than the payor; [0210, *The business rules introduced above include rules such as payment amount thresholds, payment frequency thresholds, or other business rules associated with risk processing.*]

- wherein, if it is determined that the monetary amount is not less than the first threshold, that the total monetary amount is not less than the second threshold, or that the volume is not less than the third threshold, effecting payment includes issuing a draft to the payee drawn on the payor deposit account. [210, *The business rules introduced above include rules such as payment amount thresholds, payment frequency thresholds, or other business rules associated with risk processing.*]

15. As regards claims 7 and 18, Moenickheim discloses wherein the identification of each of those of the plurality of risk reduction techniques is based upon at least one of i) the identity of the payor, ii) the identity of the payee, iii) the identity a financial institution, at which the payor maintains a deposit account, iv) the identity of a consumer service provider with which the payor is associated, and v) a type of payment service offered by the payment service provider utilized by the payor. [0351, *The extracted creditor data is then preferably processed to determine*

*those of the identified creditors that are known electronic billers. The creditors that are known electronic billers are then designated as candidate electronic billers.]*

16. As regards claims 8 and 19, Moenickheim discloses wherein two or more of the plurality of risk reduction techniques are identified as being available, and further comprising:
  - determining the one of the two or more identified risk reduction techniques which provides a highest level of protection against financial loss to the payment service provider in association with effecting payment on behalf of the payor; wherein the determined one of the risk reduction techniques is the selected risk reduction technique. *[0213, FIG. 14 is a high level overview of the activation process and initial bill delivery process that a subscriber, in this example subscriber 607C, Jane, goes through.]*
17. As regards claims 9 and 20, Moenickheim discloses wherein two or more of the plurality of risk reduction techniques are identified as being available, and further comprising:
  - determining the one of the two or more identified risk reduction techniques that is associated with a least cost; wherein the determined one of the risk reduction techniques is the selected risk reduction technique. *[0224, Preferably, there is no charge for this service to subscribers. Signing up is a very simple process*

*because the combination of .NET Passport database 1507 and .NET Profile database 1510 already holds demographic data such as home addresses and phone numbers, as well as supports identity authentication (via a password).]*

18. As regards claims 10 and 21, Moenickheim discloses wherein two or more of the plurality of risk reduction techniques are identified as being available, and further comprising:

- determining the one of the two or more identified risk reduction techniques associated with a shortest time period to complete payment to the payee on behalf of the payor; wherein the determined one of the risk reduction techniques is the selected risk reduction technique.[0074]

19. As regards claims 11 and 22, Moenickheim discloses wherein each of the plurality of risk reduction techniques is associated with a priority and two or more of the plurality of risk reduction techniques are identified as being available, and further comprising:


- determining the one of the two or more identified risk reduction techniques having a highest priority; wherein the determined one of the risk reduction techniques is the selected risk reduction technique.[0266]

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. Anderson whose telephone number is 571-270-3327. The examiner can normally be reached on Monday through Friday 8:00 to 5:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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SUPERVISORY PATENT EXAMINE  
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Examiner

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